

## **REMARKS**

Claims 1, 4-10, 12-15, 20-23, and 25-36 were pending and presented for examination and in this application. In a final Office action dated May 30, 2006, claims 1, 4-10, 12-15, 20-23, and 25-36 were rejected.

Applicant is canceling claims 10 and 36 with this Amendment and Response. Applicant is amending claims 1, 5-8, 12-15, 21-23, 25, 28, and 29 in this Amendment and Response. These changes are believed not to introduce new matter, and their entry is respectfully requested. In making these amendments, Applicant does not concede that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, Applicant reserves the right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

In view of the amendments above and remarks that follow, Applicant respectfully requests that Examiner reconsider all outstanding objections and rejections, and withdraw them.

### **Response to Rejection Under 35 USC 102(e) in View of Warren**

In the Office Action, Examiner rejects claims 1, 5, 7-10, 12-15, 20-23, and 25-36 under 35 USC § 102(e) as allegedly being anticipated by U.S. Patent No. 6,999,792 (“Warren”).

Claim 1 as amended recites:

a communication interface operable to receive first data from the handheld wireless communication device and transmit second data to the handheld wireless communication device, the first and second data being interactable by an application on the handheld wireless communication device; ... and

a processor, coupled to the alphanumeric keyboard, the communication interface, and the screen, operable to execute a peripheral application using the user input data and the first data thereby generating the second data, the peripheral application being associated with the application on the handheld wireless communication device. (emphasis added)

Support for the proposed claim amendments is found in the specification as filed at, for example, from page 8, paragraph 26 to page 9, paragraph 27 of the specification as filed. As amended, claim 1 beneficially recites a peripheral device operational with a handheld wireless communication device (e.g., a smartphone or personal digital assistant with wireless network functionality) that comprises “a processor ... operable to execute a peripheral application using the user input data and the first data thereby generating the second data, the peripheral application being associated with the application on the handheld wireless communication device.”

In the claimed configuration, the first data is *interactable* by the application on the handheld wireless communication device, and is *interacted* by the peripheral application executed on the processor of the peripheral device to generate the second data. This second data subsequently can be transmitted back to the handheld wireless communication device for storage or further operation (e.g., mobile phone network transmission).

The claimed configuration beneficially includes the peripheral application running on the peripheral device functions as an extension of the associated application on the handheld wireless communication device. This allows the peripheral device to function as an extension of the handheld wireless communication device. As an extension, the peripheral device provides a larger screen and an alpha-numeric keyboard, which typically is larger than one available on a handheld wireless communication device. Thus, the claimed configuration is beneficially structured to allow data to be manipulated and processed on a

larger peripheral device rather than a smaller handheld wireless communication device.

The inclusion of user-friendly features (e.g., spacious display and full-size keyboard relative to the handheld wireless communication device) causes less user fatigue and helps expand use of the handheld wireless communication device. Claim 25 as amended similarly recites similar claimed features and has similar benefits.

Turning now to the cited reference, Warren, it does not disclose the claimed features cited above. Warren discloses an input/output device which can work with a portable phone to access the Internet using the portable phone's wireless capability. (See Warren, col. 1, line 65 to col. 2, line 11). In the Office action, Examiner references col. 3, ll. 4-22, col. 4, ll. 36-62, col. 5, line 62 to col. 6, line 10, col. 6, line 61 to col. 7, line 8, and col. 9, ll. 51-67 of Warren for disclosure of the claimed communication interface and processor. However, col. 3, ll. 4-22 and col. 9, ll. 51-67 of Warren discloses that the input/output device can use the portable phone to access the Internet (browse website and view email) and information stored on a home or other remote computer.

Similarly, col. 4, ll. 36-62 of Warren discloses that the input/output device can use the cell phone "to communicate with and remotely access information on another computer (or network of computers such as the Internet) 30, another portable phone 32, or other electronic devices." In addition, col. 5, line 62 to col. 6, line 10 of Warren disclose that the input/output device has components such as processor, operating system, storage, and application programs. Further, col. 6, line 61 to col. 7, line 8 of Warren discloses about different mechanisms that the input/output device can use to communicate with the portable phone.

In each instance, the claimed invention differs from what Warren discloses. For example, the claimed invention recites that the data received from and transmitted to the handheld wireless communication device is “interactable by an application on the handheld wireless communication device.” In Warren, the input/output device uses the portable phone merely as a modem to connect to the Internet. The phone in Warren only serves as a pass-through conduit, which contrasts with the claimed invention in which data communicated is interactable with an application on the handheld wireless communication device.

Next, Warren also does not disclose data received from a handheld wireless communication device (the first data) being processed by a peripheral application running on the peripheral device that is “associated with the application on the handheld wireless communication device,” and the resulting data (the second data) being interactable by the associated application. Rather, the configuration in Warren is simply to allow a laptop device to use the phone as a modem to connect to a network. There is no application on the portable phone associated with peripheral applications on the input/output device and that is interactable to the data transmitted to/from the input/output device.

In view of the claim amendments and remarks above, Applicant respectfully submits that the claimed invention is patentably distinguishable over Warren. Similarly, Applicant submits that claim 25, as amended, also is distinguishable over Warren for the same reasons. Therefore, Applicant respectfully requests that Examiner reconsider the rejection, and withdraw it.

As to the dependent claims, because claims 5, 7-9, 12-15, and 20-23 are dependent on claim 1, and claims 26-35 are dependent on claim 25, all arguments advanced above with

respect to claim 1 are hereby incorporated so as to apply to claims 5, 7-9, 12-15, 20-23, and 26-35.

**Response to Rejection Under 35 USC 103(a) in View of Warren and Guerlin**

In the Office action, Examiner rejects claims 4 and 6 under 35 USC § 103(a) as allegedly being unpatentable over Warren in view of U.S. Patent No. 5,870,680 (“Guerlin”). This rejection now is respectfully traversed.

As set forth above with reference to claim 1, Warren does not disclose the claimed feature of:

a communication interface operable to receive first data from the handheld wireless communication device and transmit second data to the handheld wireless communication device, the first and second data being interactable by an application on the handheld wireless communication device; ... and

a processor ... operable to execute a peripheral application using the user input data and the first data thereby generating the second data, the peripheral application being associated with the application on the handheld wireless communication device.

The arguments set forth with respect to claim 1 are applicable for dependent claims 4 and 6, and are therefore, incorporated by reference.

Further, Warren, Guerlin also fails to disclose the claimed elements cited above. In contrast to the claimed invention, Guerlin discloses “a method and apparatus for conserving energy in a system including two devices interconnected by a data communication link.” (Guerlin, abstract, col. 3, ll. 59-62). Guerlin conserves energy by putting both devices in standby mode during periods when the two devices are inactive. (*Id.*, col. 5, line 55 – col. 7, line 48). In order to place one device (the microcomputer) on standby, the other device (the mobile telephone) either sends a “go to standby” message or ceases to send scanning messages. (*Id.*, col. 6, ll. 29-32). This disclosure in Guerlin is not what Applicant claims.

For example, Guerlin does not disclose a peripheral device having a communication interface receiving data and transmitting processed data to the handheld wireless communication device. Guerlin merely discloses a first device (the mobile telephone 1) places a second device (the microcomputer 2) on standby by means of messages: either sending a “go to standby” message or by ceasing to send scanning messages. Guerlin does not disclose the second device transmitting processed data back to the first device. Therefore, Guerlin fails to disclose the claimed features cited above.

Likewise, the combination of Warren and Guerlin also fails to disclose or suggest the claimed features cited above. As discussed above, the above claimed feature is not disclosed in either reference. However, even if the two references arguably could be combined, at best the combination provides a system and method for connecting a cellular telephone to a personal computing device, such that the personal computing device can use the cellular telephone to access a network, and the system can preserve energy consumption of the two devices by putting them in standby mode by sending or cease to send messages between them. This is not what Applicant claims. This is not a configuration in which a user of a handheld wireless communication device can use a peripheral device to interact with data from the handheld device, the data being interactable by an application on the handheld device.

Thus, alone or in combination, Warren and Guerlin do not disclose the claimed invention as recited in claims 1, 4 or 6, as presented herein. Therefore, based on the amendments and remarks herein, Applicant respectfully submits that for at least these reasons claims 4 and 6 also are patentably distinguishable over the cited references, both

alone and in combination. Therefore, Applicant respectfully requests that Examiner reconsider and withdraw the rejection to these claims.

### **Conclusion**

In sum, Applicant respectfully submits that claims 1, 4-9, 12-15, 20-23, and 25-35, as presented herein, are patentably distinguishable over the cited references (including references cited, but not applied). Therefore, Applicant requests reconsideration of the basis for the rejections to these claims and requests allowance of them.

In addition, Applicant respectfully invites Examiner to contact Applicant's representative at the number provided below if Examiner believes it will help expedite furtherance of this application.

Respectfully Submitted,  
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